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HARBECK, TIMOTHY M

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/909,587  
Filing Date: July 20, 2001  
Appellant(s): SHULER ET AL.

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For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed November 14, 2006 appealing from  
the Office action mailed July 11, 2006

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Numeral I in the brief, the examiners rejections under 35 U.S.C 112, Second Paragraph are withdrawn.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

- Bi et al (US 6,311,178 B1); "Multi-Element Confidence Matching System and the Method Therefor."
- Ordish et al (US 2001/0039527 A1); "Offer Matching System"
- Pratt (US 5,673,647); "Cattle Management Method and System."
- Non Patent Literature Gransberry (Jim Gransberry "Bull breeders keep track of the consumer." The Billings Gazette. Billings, Mont.: Oct 17, 1995. Sec A. pg 7)
- Non-Patent Literature Barrons (Barrons Financial Guides "Dictionary of Finance and Investment Terms." Page 106)

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Bi in view of Ordish in view of Gransberry.

**Re Claim 1:** Bi discloses a multi-element confidence matching system and the method therefor comprising

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- Receiving information defining a plurality of demand profiles at the information server from the buyer interface, wherein at least one of the demand profiles specifies a first pre condition (Column 2, lines 30-38; also see Table 1)
- Receiving information defining a supply profile at the information server from the producer interface, wherein the supply profile specifies a second pre-condition (Column 2, lines 30-38; also see Table 1)
- Comparing the supply profile to the plurality of demand profiles to determine whether a match exists between the supply profile and one of the demand profiles based at least in part on a comparison of the first and second pre conditions (Column 4, lines 9-29; Fig 2b).
- Providing an indication to one of the buyer interface and the producer interface of at least one matching demand profile in response to a match (Column 3, lines 57-60)

Bi does not explicitly disclose the step wherein the matching system is done with respect to a cattle market, specifically wherein the demand and supply profiles specify a pre-conditioning program comprising any of numerous protocols or criteria that govern the breeding, feeding, management and health of cattle prior to slaughter. Ordish discloses an improved matching system for trading instruments including commodities futures contracts (Page 2, paragraph 0009). It was well known in the art at the time of invention that cattle markets and the trading thereon represented a form of commodities futures contracts. It would have been obvious to anyone skilled in the ordinary art at the

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time of invention to include the teachings of Ordish to the disclosure of Bi, because commodities such as cattle were popular trading instruments and would have been simple to include in any matching or trading system.

Gransbery discloses that breeders of cattle are becoming more aware of consumer demands for the product and have started to breed cattle with this demand in mind. Therefore it would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of Gransbery to the disclosure of Bi in view of Ordish so that the producers can inform potential buyers of the cattle of the specific breeding practices in order to increase the appeal to the overall market. In producing the type of cattle that the market is demanding (and being sure to announce this fact), the breeders are more likely to achieve a higher return on their investment.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bi in view of Ordish in view of Gransbery in view of Pratt (US PAT 5,673,647).

**Re Claim 9:** Bi discloses a multi-element confidence matching system and the method therefor comprising

- Receiving information defining a supply profile at the information server from the interface wherein the supply profile specifies a precondition (Column 2, lines 30-38; also see Table 1)
- Storing the supply profile in a database associated with the cattle information server (Column 3, lines 52-54)

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Bi does not explicitly disclose the steps wherein the matching system is done with respect to a cattle market specifically wherein the demand and supply profiles specify a pre-conditioning program comprising any of numerous protocols or criteria that govern the breeding, feeding, management and health of cattle prior to slaughter.

Ordish discloses an improved matching system for trading instruments including commodities futures contracts (Page 2, paragraph 0009). It was well known in the art at the time of invention that cattle markets and the trading thereon represented a form of commodities futures contracts. It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of Ordish to the disclosure of Bi, because commodities such as cattle were popular trading instruments and would have been simple to include in any matching or trading system.

Gransbery discloses that breeders of cattle are becoming more aware of consumer demands for the product and have started to breed cattle with this demand in mind. Therefore it would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of Gransbery to the disclosure of Bi in view of Ordish so that the producers can inform potential buyers of the cattle of the specific breeding practices in order to increase the appeal to the overall market. In producing the type of cattle that the market is demanding (and being sure to announce this fact), the breeders are more likely to achieve a higher return on their investment.

Furthermore, Bi does not explicitly disclose the steps of

- Verifying, by a third party, a pre-conditioning program for an identified group of Cattle

- Receiving information defining carcass characteristics of the identified group of cattle at the time of harvest from the interface
- Storing the carcass characteristics of the identified group of cattle in a database associated with the cattle information and
- Correlating the carcass characteristics of the identified group of Cattle with the supply profile

Pratt discloses a cattle management system and method comprising the steps of verifying, receiving, storing and correlating carcass characteristics of a group (feedlot) of cattle (Column 5, lines 46-54). It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teaching of Pratt to the disclosure of Bi in view of Ordish so that the parties involved in the trading process can have a record of performance of previous cattle lots, as well as a way to track the current lot in order to control to quality of the product and ensure that previously agreed upon treatments are carried out as stipulated.

Furthermore it was notoriously well known in the art at the time of invention to utilize the services of a third party in order to verify aspects of a product or service. Therefore it would have been obvious to one of ordinary skill to include this feature to the disclosure of Bi / Ordish / Gransbery / Pratt so that both parties to the transaction can be satisfied that a neutral party has evaluated the agreement and determined that each side is in full compliance. This prevents any possible fraud or exaggeration from either party.

**(10) Response to Argument**

As noted in section (6) above, the Examiner has decided to withdraw his rejections based under 35 U.S.C 112, Second Paragraph. However, all claims remain rejected under 35 U.S.C 103 (a).

Appellant's arguments with respect to the rejections under 103(a) begin on page 10 of the brief.

The first argument presented by Appellant is that the examiner has engaged in piecemeal examination of the case, and has not considered the references and the present invention as 'a whole.' The examiner disagrees. The examiner, in constructing the obviousness argument has used the Bi reference as a base reference to show virtually every limitation of the present invention. However, as required in any obviousness rejection the examiner has also provided the perceived differences between the prior art and the present invention in the initial rejection. In the immediate case, Bi discloses a system and method that matches user profiles for goods and products with similar offers based on multiple elements (Column 1, lines 7-12). The system of Bi is not specific to any one good or product, but rather is broadly based to help 'traders to find the goods they need from the other traders, or help them to find buyers for their goods, and help them cope with a lot of business related affairs.' Therefore, while Bi discloses a broad based matching system for 'goods' it does not disclose the specific cattle market of the present invention.

The Ordish reference, also a matching system, was disclosed only to show that it was known to use matching systems for commodities futures contracts (paragraph

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0009), which includes the cattle markets (for evidence of this the examiner has provided the Downes reference, with a definition of 'commodities futures contracts,' which specifically lists cattle as one such commodity).

Finally, the Gransbery reference was submitted in response to the amended limitations consisting of specific matching criteria for the cattle market claimed by Appellant. This reference was added in order to be comprehensive with respect to these newly added limitations, but it should be noted that the 'hear' of the rejection based on the primary Bi reference was unchanged.

The examiner thus submits that the initial rejection was both proper under 103(a) and was conducted thoroughly, comprehensively and as a whole, and piecemeal examination as defined in section 707.07(g) of the MPEP has been avoided.

The next argument presented by Appellant is the alleged lack of motivation to combine Bi, Ordish and Gransbery. Specifically Appellant asserts that there is no motivation to combine the Ordish and Bi references. However, it has been found that "In many, if not most, situations, there is neither a motivation to make the modification clearly articulated in the reference nor an evident lack of motivation. Rather, the prior art references typically disclose elements or aspects of the claimed subject matter, but fail to specifically point the way toward the combination, substitution or other modification needed to arrive at the invention. A judgment must be made whether 'a person of ordinary skill in the art would have had sufficient motivation to combine the individual [elements] forming the claimed [invention].'" *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

As noted previously, the Ordish reference was provided to show that it was known prior to the present invention to utilize a matching system for commodities futures contracts, such as cattle. The Bi invention, as interpreted by the Examiner, is a matching system (like Ordish) that contains an additional level of specification with regards to the matching elements of the good or product in question. The Appellant alleges that since, in Ordish, the offer message is limited to the quantity. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this instance the examiner maintains that a person of ordinary skill in the art would have found it obvious to incorporate the teachings of Ordish, that a matching system can be used for commodities contracts, to the Bi disclosure to create a multi-element matching system for commodities contracts.

Along similar grounds, Appellant further alleges that there suggestion or motivation to combine the teachings of Gransbery to the aforementioned prior art. The Federal Circuit has stated that 'Although our predecessor court was the first to articulate the motivation-suggestion-teaching test, a related test—the "analogous art" test—has long been part of the primary Graham analysis articulated by the Supreme Court. See *Dann*, 425 U.S. at 227-29; *Graham*, 383 U.S. at 35.2 The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or

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is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. Id. (“[I]t is necessary to consider ‘the reality of the circumstances,’—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” (quoting In re Wood, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

In this instance, Gransbery is chiefly concerned with one question: How does one sell bulls in a bear cattle market? The answer, as stated is to ‘Produce the cattle that is trending toward what the consumer or packer is demanding.’ In other words, the seller needs to produce cattle (i.e. breed and condition) with specific characteristics (i.e. more than just price and quantity) that match the needs of the end consumer.

Therefore the Examiner submits that Gransbery, is certainly pertinent to the problem with which the inventor was concerned and that each of Bi, Ordish and Gransbery are analogous in that they relate to a method and system of matching a seller and a buyer with a product (specifically cattle in the case of Gransbery).

Appellant next alleges that there would be no reasonable expectation of success in combining the alleged references. Initially Appellant states both Bi and Ordish use offers, which are limited to very basic information about the product or commodity (Brief page 14). However this statement is flatly contradicted by the first paragraph of the summary of invention of Bi; “It is an object of the invention to provide a multi-element

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confidence matching system, which can automatically provide the user or trader with the information he is interested in without the intervention of the trader, and give the user the maximum amount of information about offers which may meet their requirement, so as to give the trader the ability to not just see offers which exactly match their criteria, but ones which come close or can fulfill part of, or more than, their needs, thereby the trader may conduct the search efficiently.” (Column 2, lines 12-21). The question of reasonable success thus becomes; Is it reasonable, to a person of ordinary skill, to expect success in using cattle, with specific criteria, as a product or good in the Bi system? The examiner contends that it is more than reasonable to expect success, given the Bi user’s ability to enter multiple and good-specific elements necessary for an appropriate match.

Next, Appellant argues that the combination fails to disclose all of the limitations of the claims, specifically the step of “receiving information defining a plurality of demand profiles at the cattle information server from the buyer interface, wherein at least one of the demand profiles specifies a first pre-conditioning program for a group of cattle, a pre-conditioning program comprising any of numerous protocols or criteria that govern the breeding, feeding, management, and health of cattle prior to slaughter.” (Brief pages 15-16). However as noted by the Examiner, Gransbery is chiefly concerned with a breeders ability to provide specific types of cattle that the consumer is demanding. Specifically Gransbery notes, “A terminal cross with Piedmontese produces a superior produce of palatability and more red meat.” It is of the opinion of the examiner, in view of the reference as a whole that a “terminal cross with

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Piedmontese," is a specific protocol or criteria that governs the breeding of a specific type of cattle (See abstract "Piedmontese, a smaller, compact cattle from Italy." AND Page 2, second paragraph; "Soukup was among several purebred-cattle producers..." purebred is a specific type of breeding criteria). Therefore Gransbery lists specific types of information that would be disclosed in a sale (match) between a producer and a consumer. Again Appellant erroneously states that Bi communicates offers using limited information that it would be insufficient to include to identify or describe a cattle pre-conditioning program. Bi disclose the objective to provide "the maximum amount of information about offers," which in the cattle market as disclosed by Gransbery would include breeding protocols.

With regards to the rejections of claims 5-8, the examiner maintains that since Bi discloses both a method and system for a mutli-element matching invention that the same art and rationale used to reject the method claims of the present invention can be used to reject the system through which said method is performed.

The examiner will now address Part III of Appellants Brief (Page 19) concerning the combination of the aforementioned prior art with Pratt.

With regards to Appellants argument of piecemeal examination, the examiner maintains the same argument as previously presented. Specifically, it is submitted that the initial rejection (as well as the subsequent one in response to amendments) was both proper under 103(a) and was conducted thoroughly, comprehensively and as a whole, and piecemeal examination as defined in section 707.07(g) of the MPEP has been avoided.

With regards to Appellants argument as to the lack of motivation to combine the references, the examiner submits, along similar grounds as discussed above that Pratt is analogous art. Specifically, Pratt is reasonably pertinent to the problem with which the inventor was concerned. Pratt is an automated method and system cattle management system and method for providing animal identification, measurement and value based management. As stated initially in the patent, "The present invention relates generally to the management of cattle in a feedlot for optimum beef quality and optimum return on investment to the producer and feedlot." (Column 1, lines 5-7). Therefore it appears that Pratt, like the prior art already discussed is concerned with the management and sale (matching buyers and sellers) of a product (specifically cattle in this instance).

With regards to the Official Notice position of the examiner (Brief pages 16 and 22), Appellant asserts that the noted facts are not capable of instant and unquestionable demonstration as being well known; proved by the fact that the Examiner was unable to produce a reference. However Appellant has not, before the brief, even requested documentation, let alone attempt to traverse the examiners assertion. The MPEP states: To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims

define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). The Appellant now states that the Examiners failure to produce evidence (which was never asked for), to support his logic (which was never traversed) is somehow proof that a "verifying" step in the matching process is inventive. Had Appellant appropriately addressed the statements, as required, the Examiner would have fulfilled this obligation. However, Appellants failure to does not 'prove' anything in this regard.

The examiner thus believes that this rejection should stand, as is, as it was never addressed by Appellant before today and furthermore because it is of sound reason. One must only think of such things as certificates of authenticity of a particular good or services provided by a typical escrow agent to realize the notoriousness of a 'verifying' step.

With regards to Appellants arguments that the prior art does not disclose all the limitations of claims 9-11 of the present invention, the examiner refers back to previous argument regarding the pre-conditioning program of claims 1-8 (Specifically note Gransbery's disclosure of breeding practice) as well as the immediately previous argument concerning the Appellant's failure to properly request documentation and/or traverse the examiners position of Official Notice.

In conclusion the Examiner believes that the present invention is simply an obvious modification of known matching systems for goods and products. Appellant

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believes that they have invented a new system for strictly trading cattle, and this qualifies the system as patentable because Bi does not disclose cattle (and the appropriate search terms) as a product to be traded. It should be noted though, that Bi is a broadly based patent that, in the Examiners opinion, should cover a wide variety of goods and products that can be searched and matched based upon multiple elements and characteristics. In fact the only example of a product listed in Bi is for tennis shoes (Column 13, lines 3-17). For each profile, multiple search criteria are entered that describe characteristics that the user is seeking for these tennis shoes. Does this mean that the Bi invention is only protected for systems that match tennis shoes? The examiner feels this is a gross narrowing of the intended coverage of Bi, but this is essentially what the Appellant is contending. The examiner finds that a reasonable person, of ordinary skill in the art, would find it obvious and appropriate to utilize the system of Bi to match users to a number of products with multiple search terms; not just tennis shoes. One could match automobiles (make, model, color, year), concert tickets (event, date, venue), even humans for purposes of a dating service (age, interests, hair color ect), without deviating from the spirit and scope of Bi. It is therefore the conclusion of the examiner that it would also be obvious to utilize Bi as a cattle matching system, including matching search terms or conditions appropriate to this particular good (breeding, feeding, management, health) that have been shown, via analogous prior art to be known particulars in this industry.

It is thus respectfully submitted that the rejections, based upon the prior art and evidence of record, be sustained.

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Timothy M. Harbeck



Conferees:

Richard Chilcot



Vincent Millin



**RICHARD E. CHILCOT, JR.**  
**SUPERVISORY PATENT EXAMINER**